UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,522	08/02/2001	Rabindranath Dutta	AUS920010168US1	6277

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EXAMINER
NGUYEN, TRI V

ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
	09/920,522	DUTTA ET AL.
Office Action Summary	Examiner	Art Unit	
	Tri V. Nguyen	1751	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>21 February 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-7,9-14,16-20,22 and 23</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-7,9-14,16-20,22 and 23</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   The Response to Office Action filed on February 21, 2006 amended Claims 7, 9, 10, 17,

20 and 23 and cancelled Claims 8, 15 and 15. The currently pending claims considered below

are Claims 1-7, 9-14, 16-20 and 22-23.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

3.   Claims 7 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant regards

as the invention.

      a.   Claim 7 recites the limitation "at the web retailer". There is insufficient

antecedent basis for this limitation in the claim.

      b.   Claim 9 is a dependent claim of Claim 7 and inherits the same deficiency.

Furthermore, Claim 9 recites the limitation "The method of claim 8." There is insufficient

antecedent basis for this limitation in the claim.

      c.   Claim 16 recites the limitation "The computer system of claim 15." There is

insufficient antecedent basis for this limitation in the claim.

      d.   Claim 22 recites the limitation "The computer program of claim 21." There is

insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5.   Claims 1, 2, 5, 6, 11, 12, 16 and 18 are rejected under 35 U.S.C. 102(b) as being

anticipated by Goldhaber et al. (5,855,008).

Regarding claim 1, Goldhaber et al. discloses a method for controlling personal

information of a user using a client computer system enabled to be communicatively

connected to a plurality of network entities in a network environment, comprising:

a.   storing personal information of the user at the client computer system (col 9, lines

53-67);

b.   receiving a request from a first network entity to send the personal information

stored at the client to at least one other network entity (col 7, lines 11-67);

c.   enabling the at least one other network entity to be selectable by the user (col 12,

lines 49-67);

d.   enabling the personal information to be edited (col 6, lines 50-65 and col 13, line

45 to cl 14, line 21); and

e.   sending the edited personal information from the client computer system to each

of the selected ones of the at least one other network entity (col 7, lines 11-67).

Regarding claim 2, Goldhaber et al. discloses the method of claim 1 wherein enabling

the personal information to be edited further comprises enabling the personal

information to be separately edited for each selected ones of the at least one other

network entity (col 12, lines 49-67; cl 13, lines 38-59 and col 18 lines 1-15).

Regarding claim 5, Goldhaber et al. discloses the method of claim 1 further comprising receiving an indication of a remuneration from the first network entity in response to sending the edited personal information to selected ones of the at least one network entity (col 16, lines 12-24).

Regarding claim 6, Goldhaber et al. discloses the method of claim 1 wherein receiving a request further comprises receiving, with the request, a financial incentive to comply with the request (col 7, lines 11-67 and col 12, lines 49-67).

Claims 11 and 12 describe the system of the method of claim 1; therefore, the prior arts of Goldhaber et al. as set forth above are relied upon to reject claims 11 and 12.

Regarding claim 16, Goldhaber et al. discloses the computer system of claim 15 further comprising: means for receiving a second remuneration from each of the at least one other specified network entity to which the user personal information was sent (col 7, lines 11-67; col 12, lines 49-67; col 19, lines 22-67 and col 20, lines 1-58).

Claim 18 describes a program embodied on a computer readable medium of the method of claim 1; therefore, the prior arts of Goldhaber et al. as set forth above are relied upon to reject claim 18.

6.   Claims 10, 17, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Karp et al. (US 2003/0154171 A1).

Regarding claim 10, Karp et al. discloses a method of participating in a distribution of personal information of a user in a network environment, comprising:

a.   receiving, at a second network entity, personal information of the user from the user with an indication of a requesting network entity that requested the user send the second network entity the personal information (page 2, parag. 25 and 27); and

b.   sending, from the second network entity, a second remuneration to the indicated requesting network entity in response to receiving the personal information from the user client system (page 2, parag. 25 and 27).

Claims 17 and 23 recite the system and the program embodied on a computer readable medium of the method Claim 10; therefore, the prior art of Karp et al. as set forth above in Claim 10 is relied upon to reject Claims 17 and 23.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 3, 4, 13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al. in view of O'Neil et al. (5,987,440).

Regarding claim 3, Goldhaber et al. discloses the need to prevent unauthorized release of the personal information but does not explicitly mention the use of watermarking the edited personal information before sending the personal information (col 7, lines 11-67). In an analogous art, O'Neil teaches the use of digital signature to track and prevent further distribution of personal information beyond a third party (col 6, lines 29-53 and col 9, lines 27-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Goldhaver et al. with the use of digital signature as taught by O'Neil since it was known in the art that a digital signature or watermark is used to securely deliver electronic documents and information thus preventing non-authorized distribution.

Regarding claim 4, Goldhaber et al. discloses the need to prevent unauthorized release of the personal information but does not explicitly mention the use of uniquely watermarking each one of the separately edited personal information before sending each of the separately edited personal information to each selected ones of the at least one network entity (col 7, lines 11-67). In an analogous art, O'Neil teaches the use of digital signature to track and prevent further distribution of personal information beyond a third party (col 6, lines 29-53 and col 9, lines 27-55). Therefore, it would have been

obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Goldhaver et al. with the use of digital signature as taught by O'Neil since it was known in the art that a digital signature or watermark is used to securely deliver electronic documents and information thus preventing non-authorized distribution.

Claims 13 and 19 describe a system and a program embodied on a computer readable medium of the method of claim 3; therefore, the prior arts of Goldhaber et al. as set forth above are relied upon to reject claims 13 and 19.

9.   Claims 7, 9, 14, 16, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al. (5,855,008).

Regarding claim 7, Goldhaber et al. discloses a method of participating in a distribution of personal information of a user in a network environment, comprising:

a.   receiving, at a web server accessed by a user from a client system over a network, initial personal information from the user over a network (col 9, lines 53-67);

b.   sending a request from the web server to the user requesting the user to send the initial personal information of the user to at least one other specified network entity (col 9, lines 53-67);

c.   sending, with the request, an indication of a financial incentive to comply with the request (col 16, lines 12-24 and col 12, lines 49-67);

but does not explicitly disclose

d.   receiving, at the web server, a copy of the user personal information sent to the at least one other specified network entity from the user;

e.   comparing, at the web retailer, the received copy of the user personal information with the received initial personal information; and

f.   sending a remuneration, based on the comparison, from the web server to the user for complying at least in part with the request.

Goldhaber et al. discloses the use of Trading Houses implemented on a network for facilitating transactions between the buyer and the seller by matching the records from both parties, allowing the seller to directly contact the buyer and sending a remuneration (col 19, lines 20 to col 20, lines 57). Furthermore, Goldhaber et al. teaches checking and monitoring that the user has performed a requested action prior to dispensing a remuneration (col 16, lines 12-23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Goldhaber et al., with checking that the information sent to a buyer since it was known in the art that following up on a transaction between a first and second party by a third party is used to ensure that the terms of the specific transaction were met and thus allowing for the proper remuneration to be disbursed.

Regarding claim 9, Goldhaber et al. discloses the method of claim 8 further comprising: receiving, at a web server, a first remuneration from each of the at least one other specified network entity to which the user personal information was sent (col 7, lines 11-67; col 16, lines 12-23; col 19, lines 21-67 and col 20 lines 1-58).

Claims 14 and 16 recite the system of the method Claims 7 and 9 respectively; therefore, the prior art of Goldhaber et al. as set forth above in Claim 7 and 9 is relied upon to reject Claims 14 and 16.

Claims 20 and 22 recite the program embodied on a computer readable medium of the method Claims 7 and 9 respectively; therefore, the prior art of Goldhaber et al. as set forth above in Claim 7 and 9 is relied upon to reject Claims 20 and 22.

Response to Arguments

10.   Applicant's arguments filed on February 21st 2006 have been fully considered but they are not persuasive.

1. Regarding Claims 1, 2, 5, 6, 11, 12, 16 and 18, the Applicant argues that there

Goldhaber does not teach or enable "receiving a request from a first network entity to

send the personal information stored at the client to at least one other network entity

or sending the edited personal information from the client computer system to each

of the selected ones of the at least one other network entity" (page 14). Futhermore,

the Applicant argues that Goldhaber et al. does not teach or enable "editing of the

personal information stored at the client system or enabling editing of the personal

information for each of the selected ones of at least on other network entities that the

user selects" (page 17). The Examiner notes that Goldhaber et al discloses that

advertisers (one or more network entities) can request personal information from the

Cybercoin/Trading Houses/Attention Brokage System (different one or more network

entities, such as a server or a user's computer) and that the user is allowed to select

the advertisers, edit "his profile at any time" and give consent on "case-by-case"

basis (col 6, line 50 to col 7, line 10, col 12 lines 48 to col 13, line 52 and col 14, lines

48-60).

2. Regarding Claims 3, 4, 13 and 19, the Applicant argues that "applying digital

signature does not teach or suggest applying digital watermark" (page 27). The

Examiner notes that it is known in the art that one of the use of digital signature is as

a digital watermark to ensure that the critical information (such as personal

information) can be tracked. The teaching of O'Neil et al. regarding the digital

signature that is attached to document as a security tool in transmitting documents

electronically over a network is applicable to "watermarking" a document for

transmission over the Web as set forth on pages 15 and 16 of the present

specifications (in particular the Applicant is silent as to a special definition of watermarking).

3. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

11. Applicant's arguments with respect to claims 7, 9, 10, 13, 14, 16, 17, 20, 22 and 23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,
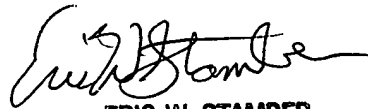
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri V. Nguyen whose telephone number is (571) 272-6965. The examiner can normally be reached on M-F 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029 and Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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